

Discussion of Amendments to Claims 1-5, 9-12 and 14 and new Claims 22-28.

The applicants had previously argued that all claims of the application were allowable over these references. The applicants asserted that Lancesseur required four (4) components to be present for his composition, whereas the applicants' composition only required two (2) components or at most three (3) components. The USPTO rejected these arguments and asserted that "[t]he applicant has presented a comprising claim, which does not prevent the application of additional features already in the references." In the same vein, the USPTO further asserted that "... the applicant has presented a comprising claim, which does not prevent the application of additional features already in the references."

In response thereto, the applicants have amended Claims 1-5 and 9-12 and 14 to replace the transitional phrase, "comprising", with the transitional phrase, "consisting essentially of." The applicants have also added new Claims 22 through 28, each of which also contains this transitional phrase. While an additional component has been added to the composition claimed in these new claims, the newly claimed composition is still distinguishable from the disclosure of Lancesseur because it only requires three (3) components and because of the use of transitional language in the preamble of these new claims.

Lancesseur teaches a polymer-based, dehydrating material

requiring the presence of four components; a) 50-80% of thermoplastic or thermosetting polymer, b) 20-50% of a dehydration agent, c) 2-8% of an elastomer, and d) 1-4% of a fiber. See col. 1, line 39-47 and col. 2, line 16-24. The presence of each of these four materials is specifically required by Lancesseur and provided the justification for the allowance of the Lancesseur application over the prior art.

In contrast, the material that is claimed in the applicants' invention requires either only two of the four Lancesseur components i.e. a plastic material and a desiccating material (Claims 1-5 and 9-14) or only three of the four Lancesseur components, a dehydration agent, a polymer and an elastomer (new Claims 22 - 28). The use of a fiber material, which is a required component in Lancesseur, is not required by any of these claims. Thus, based on the amended transitional language of the claims, the composition of the material claimed by the applicants is not disclosed by Lancesseur in these claims.

The USPTO has indicated that an amendment of this type would make these claims allowable over the prior art. Specifically, the Examiner noted in the final Office Action, that the transitional phrase "comprising", that is present in the prior claims, does not distinguish the claims over Lancesseur. The applicants have responded to this argument by amending the claims to introduce the more restrictive transitional phrase, "consisting essentially of."

The applicants assert that by this amendment, the listed claims are in condition for allowance.

New Claims 29, 30 and 31.

These three new claims are all dependent claims depending on independent Claims 1, 10 and 22. These claims claim the same composition that is claimed in these independent claims and additionally claim that the tray for holding the integrated circuits does not contain a desiccating material. Bases for these claims is contained on page 21, lines 20 - 22, and page 14, lines 10 -17. No new subject matter is introduced by these amendments. Each of these three claims is also allowable as they are merely dependent claims depending upon now allowable independent claims.

New Claims 32 - 37.

New Claim 32 is an independent claim, claiming the composition that is claimed in independent Claim 1, except the transitional phrase, "consisting essentially of", has been replaced by the non-limiting transitional term, "comprising." In addition, the composition of the tray is limited to not include a desiccating material. (This limitation is also claimed in Claims 29-31.) Finally, the composition of the tray cover has been amended to require that the ratio of the plastic material contained in the tray cover to the desiccating material must be from 50:40 to about

30:65. Bases for this amendment is contained on page 16, line 21 through page 17, line 5. No new subject matter is introduced by these amendments.

The applicants assert that new Claims 32 - 37 are allowable over the prior art, particularly the combination of Pakeriasamy '573 in view of Lancesseur. The USPTO in its rejection of the previously filed claims, asserted that Lancesseur discloses the composition, as claimed in the application. In fact, the composition that is preferred by Lancesseur is significantly different from that claimed by the applicants in these new claims. In Lancesseur, as disclosed in his examples, the ratio of the polymer-containing material to the desiccating material is over 2:1. The ratio of the polymer material to the desiccating material that is disclosed in the specification and is claimed in Claim 1 is at least 1:1 and preferable as high as 4:1. A person skilled in the art reviewing Lancesseur and attempting to prepare materials for the use disclosed in Pakeriasamy would be taught to use a greater amount of the polymer material than desiccating material. This fact is clearly shown by the working examples in Lancesseur, where the amount of the polymer material is at least twice that of the desiccating material. In contrast, the applicants have discovered that for this type of tray cover the amount of desiccant material should be greater than polymer material. The ratio of the polymer material to desiccating material in this ratio is claimed

in new Claim 32. This new claim is distinguishable from what is suggested and taught by the combination of Pakeriasamy '573 and Lancesseur.

In addition, the applicants also claim that the tray should be made of a material not containing a desiccating material. Neither Pakeriasamy '573 nor Lancesseur teach or suggest that the composition of the tray can be different from that of the tray cover. In fact, in Pakeriasamy '573 the composition of these components is the same. Further, Lancesseur teaches that his composition must include a desiccating material to function. In contrast, the composition of the tray of the application, as claimed in Claims 32-37, does not include a desiccating material. For all of these reasons, Claims 32-37 are patentable over the cited prior art.

STATUS OF CLAIMS

The status of the claims of the application follows: